

REMARKS

Reconsideration and allowance are respectfully requested.

The amendments proposed in this Response address the issues on page 3 of the office action. No new matter has been added. Entry and allowance are requested.

Regarding drawing corrections claims 5, 12 and 19 have been amended as above rendering moot the drawing objections on page 2 of the office action. Withdrawal of the objections is respectfully requested.

Claims 1-3, 5-10, 12-17, and 19 are patentable under 35 U.S.C. 102(b) over Schluger (US Patent 5,682,990).

The present claims generally define a book format package comprising a cover with a rigid front and a rigid back and a flexible spine disposed between the rigid front and the rigid back. Further more, a stack of one or more rigid trays are disposed between the rigid front and back. Each rigid tray of the stack of trays is attached to the cover at the flexible spine by curing a binding material adhesive on the flexible spine.

For an invention to be anticipated, it must be demonstrated that each and every element of the claimed invention is present in the "four corners" of a single prior art, either expressly described therein or under the principle of inherency. Lewmar Marine Inc. v Barient Inc., 3 USPQ2d 1766, 1767-1768 (CAFC, 1987). The absence from prior art reference any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible, Inc., 230 USPQ 81, 84 (Fed. Cir. 1986).

Schluger relates to a point-of-sale CD holder in which holder 16 is made of a die cut cardboard blank 18 forming front and back covers 20, 22. A spine panel 30 extends between the covers. Blank 18 when assembled forms a book-like configuration.

Holder 16 includes a cardboard blank 46 forming a box 48 with front panel 50, rear panel 52, top and bottom panels 54, 56 and internal adhesive flap 60. A lateral connection flap 62 is adhesively secured to the spine 30 and has unclosed panel edges 64 bounding a rear opening 66 of a CD storage compartment 68. Panel edges 72 bound box opening 74 to load a packaged CD. Exposed surfaces 44, 48 can be used to display information conveying text.

Nothing in Schluger describes, teaches, or suggests the claimed package with a plurality of trays and each tray attached to a flexible spine so that any number of storage media can be accommodated between the front and back covers of the book format package. Schluger provides a single box for receiving a packaged CD and even that single box is attached to panel edges 64 of a connecting flap 62 secured to the spine 30. That has nothing to do with the claimed invention defined by the present claims.

To be anticipating, a prior art reference must disclose "each and every limitation of the claimed invention[,]... must be enabling[,] and must describe...[the] claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

The prior art reference must disclose every feature of the claimed invention, either explicitly or inherently. Hazani v. U.S. Intern. Trade Comm., 44 USPQ2D 1358 (Fed. Cir. 1997).

"Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. Continental Can Co. v. Monsanto Co., 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

Claims 1-4, 6-11, and 13-18 are patentable under 35 U.S.C. 103(a) over Roze (US Patent 4,823,950) in view of Fraser et al. (US Patent 6,523,683).

The present claims generally define a book format package comprising a cover with a rigid front and a rigid back and a flexible spine disposed between the rigid front and the rigid back. Further more, a stack of one or more rigid trays are disposed between the rigid front and back. Each rigid tray of the stack of trays is attached to the cover at the flexible spine by curing a binding material adhesive on the flexible spine.

Roze relates to a storage container 10 with a frame 30 of specific dimensions. Planar members 25, 45 on respective frames 26, 46 form a pair of disc compartments to hold four discs. Frame 30 has an optical disc container support 70 with frame elements 72, 72 to hold four more discs. Flexible securing member 60 secures frame 30 and planar members 25, 45. Adhesive strips 81, 82 on container support 70 secures optical disc containers therein. Planar members 25, 45 are adhesively attached frame means 26, 46.

Fraser relates to a storage container 10 with an outer shell 12 and drawer 14 which receives and stores discs 16 and printed matter 17. Container 10 has integral tamper seal 86 which fractures non-reversibly the first time the drawer 14 is removed from the shell 10. Peel-off closure means 6 may be secured by adhesive that may be heat-cured or cured by ultraviolet or infrared radiation. Fraser expressly teaches that the adhesive must be of the nature which does not readily re-seal once the bond is broken.

Firstly, the examiner's reliance on Fraser's tamper resistant irreversible adhesive sealing means to negate the claimed invention is misplaced. Secondly, the examiner's attempt to make a mental jump from a one-time sealing means to be employed in Roze's securing member 60 to attach Roze's frame to the spine derives the claimed invention and the present teachings and cannot form a proper basis for any obviousness holding.

"It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 23 USPQ2d 1783, 1784 (CAFC, August 1992), quoting from In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). "This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." Id. quoting from In re Fine, 5 USPQ2d 1600 (CAFC, 1988).

Moreover, the examiner's extrapolation of Fraser's teachings

as applied to Roze would do harm to Roze's storage container because with Fraser's express teaching of irreversible adhesive bond breaking the Roze frame will fall off of the Roze spine. And, despite that, the end result will have nothing to do with the claimed invention.

Citing In re Gordon, 221 USPQ, 1127, the court pointed out, "the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification". In re Fritch, 23 USPQ2d 1783, 1784 (CAFC, August 1992). In the same case, In re Gordon, the court found a proposed modification inappropriate for an obviousness inquiry when the modification rendered the prior art reference inoperable for its intended purpose.

Claims 5, 12, and 19 are patentable under 35 U.S.C. 103(a) over Roze (US Patent 4,823,950) in view of Fraser et al. (US Patent 6,523,683) further in view of Schluger (US Patent 5,682,990).

As pointed out above Roze and Fraser do not describe, teach nor suggest the claimed invention. Therefore, any further combination with other references will also lead away from the claimed invention.

Schluger relates to a point-of-sale CD holder in which holder 16 is made of a die cut cardboard blank 18 forming front and back covers 20, 22. A spine panel 30 extends between the covers. Blank 18 when assembled forms a book-like configuration.

Holder 16 includes a cardboard blank 46 forming a box 48

with front panel 50, rear panel 52, top and bottom panels 54, 56 and internal adhesive flap 60. A lateral connection flap 62 is adhesively secured to the spine 30 and has unclosed panel edges 64 bounding a rear opening 66 of a CD storage compartment 68. Panel edges 72 bound box opening 74 to load a packaged CD. Exposed surfaces 44, 48 can be used to display information conveying text.

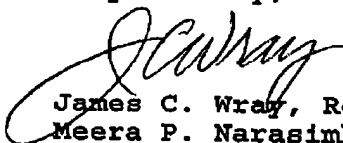
Nothing in Schluger describes, teaches, or suggests the claimed package with a plurality of trays and each tray attached to a flexible spine so that any number of storage media can be accommodated between the front and back covers of the book format package. Schluger provides a single box for receiving a packaged CD and even that single box is attached to panel edges 64 of a connecting flap 62 secured to the spine 30. That has nothing to do with the claimed invention defined by the present claims.

Obviousness is tested by what the combined teachings of the references would have suggested to those of ordinary skill in the art. It cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Teachings of references can be combined only if there is some suggestion or incentive to do so. In re Fine, 5 USPQ2d 1596, 1599 (CAFC, 1988).

Nothing in the references, either singly or in combination, teaches or suggests the claimed features. Therefore, the references cannot anticipate nor render obvious the present invention as claimed.

Since Applicant has presented a novel, unique and non-obvious invention, reconsideration and allowance are respectfully requested.

Respectfully,



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